

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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|-------------|------------------------|---|-----------------|-----------------|
| Applicant: | Vincent R. Koser | § | Group Art Unit: | 3622 |
| | | § | | |
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| | | § | | |
| Filed: | July 31, 2003 | § | Examiner: | Rodney M. Henry |
| | | § | | |
| For: | SYSTEM AND METHOD FOR | § | Atty. Dkt. No.: | 11446.10 |
| | EXECUTION OF CUSTOMER- | § | | |
| | SPECIFIC MARKETING, | § | | |
| | DISCOUNTS, AND | § | | |
| | PROMOTIONS | § | | |

BRIEF IN SUPPORT OF APPEAL

Sir:

This brief in support of appeal is filed in support of Applicant's notice of appeal filed on November 8, 2010, in response to a final rejection dated June 8, 2010, in this matter. In addition, Applicant filed a pre-appeal brief with the notice of appeal. On January 6, 2011, the Office issued a Notice of Panel Decision stating the case should proceed to the Board of Patent Appeals and Interferences. Please provide any extensions of time that may be necessary and charge any fees that may be due to Account No. 14-0225, but not to include any payment of issue fees.

(1) REAL PARTY IN INTEREST

The real party in interest in this matter is NCR Corporation, Duluth, Georgia, by virtue of an assignment recorded at reel 014673, frame 0937-0039, on November 7, 2003.

(2) RELATED APPEALS AND INTERFERENCES

Applicant is not aware of any appeals or interferences related to this patent application (serial no. 10/631,181).

(3) STATUS OF CLAIMS

Claims 1-22 are currently pending in the application and have been rejected two or more times. This is an appeal from the June 8, 2010 final Office Action (“Office Action”) rejecting all pending claims. The claims, as currently pending, are listed in an Appendix to this Appeal Brief.

(4) STATUS OF AMENDMENTS

Applicant has filed no amendment after receipt of the Office Action. The claims stand as last presented on June 8, 2010.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

(A) EXPLANATION:

The present invention relates to systems, methods and a device for execution of marketing, discounts, and promotions at a point-of-sale computer. One of the systems includes a point-of-sale computer at a checkout counter that identifies and processes items presented for purchase. Additionally, the system includes a customer interface device located at the checkout counter and in communication with the point-of-sale computer where the device alerts a customer to the existence of a promotion for a item processed by the point-of-sale computer and transfers details of the promotion to the point-of-sale computer. The details of the promotion appear as bar code data to the point-of-sale computer.

(B) CLAIMS WITH SPECIFICATION SUPPORT

Re: Independent Claim 1

According to one embodiment of the current invention, claim 1 addresses a system for executing promotions comprising a point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification by the point-of-sale computer, as discussed in the specification on page 9, first full paragraph and illustrated in Fig. 1, element 12.

The system further comprises a customer interface device at the checkout counter and in communication with the point-of-sale computer for alerting a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer and for transferring details of the promotion to the point-of-sale computer, wherein the details of the promotion appear as bar code data to the point-of-sale computer, as illustrated in Fig. 1, element 14 and as discussed in the specification on page 1, second paragraph of Summary of the Invention and page 5, first paragraph.

The system also comprises a local promotional server wirelessly connected to the customer interface device for sending the details of the promotion to the customer interface device, as illustrated in Fig. 1, element 16 and as discussed in the specification on page 5, second paragraph, first 4 lines and page 9, first full paragraph – page 10, line 3.

Re: Independent Claim 3

According to one embodiment of the current invention, claim 3 addresses a method of delivering a promotion comprising the following steps. Collecting and storing information about a customer as discussed in the specification on page 14, first full paragraph and as illustrated in Fig. 4A, element 106. Generating a promotion based upon the information about the customer, *Id.* Determining that the customer is presenting items for identification and purchase at a checkout counter as discussed in the specification on page 9, first full paragraph and as illustrated in Fig. 4A, element 100. Wirelessly delivering details of the promotion to a customer interface device at the checkout counter, as discussed in the specification on page 5, second paragraph, lines 1-5 and page 9, first

full paragraph, line 14 – page 10, line 1 and as illustrated in Fig. 1, elements 14 and 16 connected with an “RF Link”. Receiving item identification information at the customer interface device for items presented at the checkout counter for purchase as discussed in the specification on page 9, second paragraph, lines 1-13 and as illustrated in Fig. 1, elements 12 and 14. Displaying a message to the customer informing the customer that the customer is to receive the promotion for an item presented at the checkout counter for purchase as discussed in the specification on page 1, second paragraph of Summary of the Invention section, lines 3-4. Sending the details of the promotion to a point-of-sale computer at the checkout counters, including sending the details as bar code data, as discussed in the specification on page 10, lines 1-9 and as illustrated in Fig. 1, elements 12 and 14. Executing the promotion by the point-of-sale computer as discussed in the specification on page 10, first full paragraph and as illustrated in Fig. 4A, element 116.

Re: Independent Claim 4

According to one embodiment of the current invention, claim 3 addresses a system for executing promotions comprising the following elements. A point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification as discussed in the specification on page 3, first two full paragraphs and as illustrated in Fig. 4A, elements 100 and 102. A customer identification device at the checkout counter as discussed in the specification on page 7, last three lines – page 8, first two lines and as illustrated in Fig. 1, element 24 and on page 8, lines 5-8. A customer interface device at the checkout counter, including a display as discussed in the specification on page 1, Summary of the Invention section, paragraph two, line 3 and on page 4, first full paragraph and as illustrated in Fig. 1, elements 14 and 12. A local promotional server for wirelessly sending details of a promotion to the customer interface device as discussed in the specification on page 1, Summary of the Invention section, paragraph two, last four lines and as illustrated in the Fig. 1, elements 14 and 16. Wherein the customer interface device displays a message informing a customer that the customer is to receive the promotion for an item presented for purchase and transfers the details of the

promotion to the point-of-sale computer for processing by the point-of-sale computer as discussed in the specification on page 1, Summary of the Invention section, paragraph two.

Re: Independent Claim 20

According to one embodiment of the current invention, claim 20 addresses a customer interface device comprising the following elements. A processor as discussed in the specification on page 4, first full paragraph, lines 1-2. A customer identification device as discussed in the specification on page 8, lines 5-8. A display for displaying a message alerting a customer to a promotion earned by the customer as discussed in the specification on page 4, first full paragraph and page 16, first full paragraph. Wireless local area network communication circuitry for communicating with a local promotional server as discussed in the specification on page 5, second full paragraph.

Wherein the processor receives customer identification information from the customer identification device (page 8, lines 5-8), receives from a point-of-sale terminal purchased item information on an item presented for purchase at the point-of-sale terminal (page 5, lines 2-6; page 9, first full paragraph), sends the customer identification information and the purchased item information to the local promotional server over a wireless local area network (page 9, first full paragraph; page 5, second full paragraph), receives discount parameters from the local promotional server over the wireless local area network (page 9, first full paragraph – page 10, line 3), displays a message to the customer informing the customer that the customer is to receive the promotion (page 1, Summary of the Invention section, second paragraph), and sends a discount transaction based upon the discount parameters to the point-of-sale terminal (page 1, Summary of the Invention section, second paragraph).

Re: Independent Claim 22

According to one embodiment of the current invention, claim 22 addresses a method of delivering a promotion comprising the following steps. Collecting and storing information about a customer as discussed in the specification on page 14, first full paragraph and as illustrated in Fig. 4A, element 106. Receiving customer identification

information from a customer identification device as discussed in the specification on page 8, lines 5-8. Receiving purchased item information from a point-of-sale terminal for an item presented to the point-of-sale terminal for identification as discussed in the specification on page 5, first paragraph. Sending the customer identification information and the purchased item information to a local promotional over a wireless local area network as discussed in the specification on page 5, second paragraph, page 8, first full paragraph, lines 1-3, and page 9, first full paragraph. Determining a promotion based upon the information about the customer by the local promotional server as discussed in the specification on page 9, first full paragraph. Wirelessly receiving discount parameters associated with the promotion from the local promotional server over the wireless local area network as discussed in the specification on page 5, second paragraph and page 9, last two lines and line one of page 10. Displaying a message to the customer informing the customer that the customer is to receive the promotion as discussed in the specification on page 1, second paragraph of Summary of the Invention section, lines 3-4. Sending a discount transaction based upon the discount parameters to the point-of-sale terminal as discussed in the specification on page 10, lines 1-3.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether claims 1-7, 9-13, 16-18, 20 and 22 stand properly rejected under 35 U.S.C. § 102(e) as being anticipated by Swartz et al. (U.S. Pub. No. 2003/0132298; hereafter “Swartz”).

(B) Whether dependent claims 8, 14 and 19 stand properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz in view of Sloane (U.S. Patent No. 5,918,211).

(C) Whether dependent claim 15 stands properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz in view of Sloane and in further view of Panofsky et al. (U.S. Pub. No. 2002/0161476; hereafter “Panofsky”).

(7) ARGUMENT

(A) The Office has rejected claims 1-7, 9-13, 16-18, 20 and 22 under 35 U.S.C. § 102(e) as being anticipated by Swartz. This rejection includes all active independent

claims of the present application. The United States Court of Appeals for the Federal Circuit has stated:

“To anticipate a claim, a single prior art reference must expressly or inherently disclose each claim limitation.... But disclosure of each element is not quite enough- this court has long held that ‘[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim.*’ *Id.* at 1334 (quoting *Connell*, 722 F.2d at 1548). In all of these cases, the prior art reference had to show the claimed invention arranged or combined in the same way as recited in the claim in order to anticipate. We thus hold that unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008)

As will be illustrated below, the Office has failed to establish a *prima facie* case of anticipation because it has failed to cite a prior art reference that anticipates all of Applicant’s claimed limitations arranged or combined in the same way as recited in the claims. Thus, the rejection is in error.

Re: Claim 1

Claim 1 addresses a system for executing promotions at point-of-sale computer using a customer interface device and local promotional server. Claim 1 reads as follows:

1. A system for executing promotions comprising:
 - a point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification by the point-of-sale computer;
 - a customer interface device at the checkout counter and in communication with the point-of-sale computer for alerting a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer and for transferring details of the promotion to the point-of-sale

computer, wherein the details of the promotion appear as bar code data to the point-of-sale computer; and

a local promotional server wirelessly connected to the customer interface device for sending the details of the promotion to the customer interface device.

Independent claim 1 is rejected as being anticipated by Swartz. Applying the legal principles set forth above and addressed further below, claim 1 is not anticipated by Swartz.

Swartz discloses an interactive shopping system that includes a portable data terminal. In a preferred embodiment, the terminal has a limited number of activation buttons for performing various user functions. These include a “plus” key to add an item selected by a consumer to a list of purchased items. (See Swartz, paragraph 46.) “The customer proceeds through the retail facility and uses the portable terminal 240 to record purchases.” (Swartz, paragraph 96.) Data collected with the terminal is wirelessly communicated to a central host. (See Swartz, paragraph 41 and 42.) Swartz further teaches a point-of-sale terminal that is used to receive payment from customer after they have selected items for purchase and to process customers not using portable terminals. (See Swartz, paragraph 85.)

Applicant requires “a point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification by the point-of-sale computer.” Swartz teaches that a customer uses a portable data terminal to record purchases as the customer proceeds through a retail facility. Conversely, Applicant requires that items for purchase be presented to the checkout counter for scanning and identification by a point-of-sale computer. Swartz does not teach this limitation as arranged in the claim. Swartz does teach the presence of a point-of-sale terminal but it is used only to receive payments from customers using a portable data terminal or for scanning items and receiving payment from customers not using a portable data terminal. As show below, Applicant requires a customer interface device at the checkout counter with the point-of-sale computer where the point-of-sale computer performs item scanning and identification. Swartz’s point-of-sale terminal either does not scan and identify items

presented for purchase or does not involve a customer interface device. Therefore, Swartz fails to anticipate Applicant's claimed limitation as arranged in the claim.

Applicant requires "a customer interface device at the checkout counter and in communication with the point-of-sale computer for alerting a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer...." As shown above, Swartz teaches that items for purchase are record by the portable data terminal instead of a point-of-sale computer, as required by Applicant. Swartz further teaches that the point-of-sale terminal is only used to receive payment for items recorded for purchase by the portable data terminal or to scan and purchase items when no portable data terminal is involved. When Swartz's portable data terminal is present at the point-of-sale terminal, the point-of-sale terminal does not scan or identify items being purchased, as required by Applicant. If the point-of-sale terminal is not scanning or identifying items for purchase, Swartz's portable data terminal cannot alert a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer, as required by Applicant. Therefore, neither the portable data terminal or the point-of-sale terminal as taught by Swartz equates to or anticipates the customer interface device or the point-of-sale computer required by Applicant.

Applicant requires "a customer interface device ... for transferring details of the promotion to the point-of-sale computer, wherein the details of the promotion appear as bar code data to the point-of-sale computer." In the rejection, the Office makes only one reference to a barcode stating "see [para. 0108] via The code could be in the form of a one dimensional barcode for looking up the relevant information in a database." (Office action mailed June 8, 2010, page 3, second to last paragraph.) Paragraph 108 of Swartz discloses "once the central processing system has successfully retrieved the customer information from the portable terminal 240, the customer then proceeds to a checkout register 170 for payment of the products selected ... The receipt printer prints out the entire list of all purchased items. The receipt preferably has a code for determining all of the products (and their cost) purchased by the customer. The code could be in the form of a one dimensional barcode for looking up the relevant information in a database." This is clearly not what is required by Applicant. The code printed on the receipt is for determining all of the

purchased products and does have details of promotion. Further, the receipt is not printed by a customer interface device and is not used by a customer interface device to transfer details of a promotion to a point-of-sale computer, as required by Applicant. The paragraph cited by the Office just does not show or suggest the limitations required by Applicant. The Office has therefore failed to establish a *prima facie* case of anticipation because it is failed to provide prior art that discloses the claimed limitations.

In rejecting this claim, the Office further states “see [FIGS 6, 9, para 0211] via The system could also use the information in determining whether to send a promotional message to a customer.” (Office action mailed June 8, 2010, page 3, third to last paragraph.) Paragraph 211 of Swartz teaches “The system may utilize the information stored in the customer shopping list to select messages to send to the customer. ... The system could also use the information in determining whether to send a promotional message to a customer. For instance, if a customer has on his electronic list a particular item, the system may not offer a discount to the customer to purchase this item. Since the customer’s shopping list indicates that the customer already has a predisposition to purchase the product.” Applicant is at a loss to understand how this passage in Swartz anticipates any of the limitations of claim 1. First, the product information is in the form of a shopping list and not from items being scanned and identified by a point-of-sale computer, as required by Applicant. Next, identifying the present of product information on the shopping list may cause Swartz’s invention to not send a discount offer to the customer because of a predisposition to purchase the item. Again, this differs from the limitations required by Applicant in that Applicant provides a promotion when the point-of-sale computer scans and identifies certain items. Clearly, this citation by the Office does not provide any support for the rejection.

In view of the above analysis and errors made by the Office, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse this rejection.

Re: Claims 3, 4, 20 and 22

The remaining independent claims contain one or more of the above discussed limitations found in claim 1 and they have been rejected for the same reasons. Therefore,

one or more of the same errors described above for claim 1 have been made regarding these claims. In view of this, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection for each claim.

(B) The Office has rejected dependent claims 8, 14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over Swartz in view of Sloane. Sloane teaches a system and method for influencing and potentially altering a consumer's purchase decisions at the point-of-purchase in a retail store using a portable bar code scanner. (See Sloane abstract.) Sloane's teachings fail to show or suggest the above limitations that the Office has failed to establish are disclosed by Swartz.

The Office has failed to establish a *prima facie* case of obviousness because it has failed to provide evidence that the references show or suggest all the required elements of Applicant's claimed invention. The claims have thus been improperly rejected by the Office. In view of this error, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse this rejection.

(C) The Office has rejected dependent claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Swartz in view of Sloane and in further view of Panofsky. Panofsky teaches "a system and method for the contemporaneous use of a vending machine and host terminal to interact with digital files." (Panofsky, Abstract.) Panofsky's teachings also fail to show or suggest the above limitations missing from the other references cited by the Office.

The Office has failed to establish a *prima facie* case of obviousness because it has failed to provide evidence that the references show or suggest all the required limitations of Applicant's claimed invention. The claim has thus been improperly rejected by the Office. In view of this error, Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse this rejection.

CONCLUSION

The Board of Appeals is respectfully requested to reverse the rejections of claims 1-22 and promptly allow the application.

Respectfully submitted,

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(Filed Electronically)

/Harden E. Stevens, III/

Harden E. Stevens, III
Reg. No. 55,649

NCR Corporation, ATT: IP Law
3097 Satellite Blvd.
Satellite Place, Building 700
Duluth, GA 30096

(803) 939-6505
(803) 939-5521 (fax)
Email: steve.stevens@ncr.com

(8) CLAIMS APPENDIX

(Claims Under Appeal)

1. A system for executing promotions comprising:

a point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification by the point-of-sale computer;

a customer interface device at the checkout counter and in communication with the point-of-sale computer for alerting a customer to the existence of a promotion for an item scanned at the checkout counter by the point-of-sale computer and for transferring details of the promotion to the point-of-sale computer, wherein the details of the promotion appear as bar code data to the point-of-sale computer; and

a local promotional server wirelessly connected to the customer interface device for sending the details of the promotion to the customer interface device.

2. The system as recited in claim 1, further comprising:

a central promotional server for sending the details of the promotion to the local promotional server, wherein the local promotional server and the central promotional server are connected by a global network.

3. A method of delivering a promotion comprising:

collecting and storing information about a customer;

generating a promotion based upon the information about the customer;

determining that the customer is presenting items for identification and purchase at a checkout counter;

wirelessly delivering details of the promotion to a customer interface device at the checkout counter;

receiving item identification information at the customer interface device for items presented at the checkout counter for purchase;

displaying a message to the customer informing the customer that the customer is to receive the promotion for an item presented at the checkout counter for purchase;

sending the details of the promotion to a point-of-sale computer at the checkout counters, including sending the details as bar code data; and
executing the promotion by the point-of-sale computer.

4. A system for executing promotions comprising:

a point-of-sale computer at a checkout counter for processing a purchase of items presented to the checkout counter for scanning and identification;

a customer identification device at the checkout counter;

a customer interface device at the checkout counter, including a display; and

a local promotional server for wirelessly sending details of a promotion to the customer interface device;

wherein the customer interface device displays a message informing a customer that the customer is to receive the promotion for an item presented for purchase and transfers the details of the promotion to the point-of-sale computer for processing by the point-of-sale computer.

5. The system as recited in claim 4, wherein the customer interface device further comprises:

a printer for printing the details of the promotion.

6. The system as recited in claim 4, wherein the local promotional server communicates with the customer interface device over a wireless local area network.

7. The system as recited in claim 4, further comprising:

a central promotional server for sending the details of the promotion to the local promotional server, wherein the local promotional server and the central promotional server are connected by a global network.

8. The system as recited in claim 4, wherein the local promotional server stores identification information for loyalty program members, receives customer identification

information from the customer identification device, and determines that the customer has earned the promotion.

9. The system as recited in claim 4, wherein the customer identification device includes a card reader.

10. The system as recited in claim 4, wherein the customer identification device includes a bar code reader.

11. The system as recited in claim 4, wherein the customer identification device includes a keyboard.

12. The system as recited in claim 4, wherein the customer identification device is coupled to the point-of sale terminal, and wherein the point-of-sale terminal sends customer identification information to the customer interface device.

13. The system as recited in claim 4, wherein the customer identification device is coupled to the customer interface device.

14. The system as recited in claim 7, wherein the local promotional server stores first identification information for first loyalty program members, receives customer identification information from the customer identification device, attempts to verify that the customer is a member of a customer loyalty program by comparing received identification information to the first customer identification information.

15. The system as recited in claim 14, wherein the central promotional server stores second identification information for second loyalty program members, and wherein the local promotional server compares the received identification information to the second customer identification information if the received identification information cannot be found in the first customer identification information.

16. The system as recited in claim 4, wherein the point-of-sale computer sends item identification information associated with the items to the customer interface device, wherein the customer interface device sends the item identification information to the local promotional server, wherein the local promotional server determines that the item identification information triggers a discount based upon the details of the promotion and sends discount parameters to the customer interface device, and wherein the customer interface device sends a discount transaction to the point-of-sale terminal.

17. The system as recited in claim 16, wherein the customer interface device sends the discount transaction to the point-of-sale terminal in bar code data format.

18. The system as recited in claim 4, wherein the customer interface device displays advertisements.

19. The system as recited in claim 4, wherein the customer interface device completes a sweepstakes registration process.

20. A customer interface device comprising:

- a processor;

- a customer identification device;

- a display for displaying a message alerting a customer to a promotion earned by the customer; and

- wireless local area network communication circuitry for communicating with a local promotional server;

- wherein the processor receives customer identification information from the customer identification device, receives from a point-of-sale terminal purchased item information on an item presented for purchase at the point-of-sale terminal, sends the customer identification information and the purchased item information to the local promotional server over a wireless local area network, receives discount parameters from

the local promotional server over the wireless local area network, displays a message to the customer informing the customer that the customer is to receive the promotion, and sends a discount transaction based upon the discount parameters to the point-of-sale terminal.

21. The system as recited in claim 20, wherein the processor communicates with the point-of-sale terminal as a bar code reader.

22. A method of delivering a promotion comprising:

- collecting and storing information about a customer;
- receiving customer identification information from a customer identification device;
- receiving purchased item information from a point-of-sale terminal for an item presented to the point-of-sale terminal for identification;
- sending the customer identification information and the purchased item information to a local promotional over a wireless local area network;
- determining a promotion based upon the information about the customer by the local promotional server;
- wirelessly receiving discount parameters associated with the promotion from the local promotional server over the wireless local area network;
- displaying a message to the customer informing the customer that the customer is to receive the promotion; and
- sending a discount transaction based upon the discount parameters to the point-of-sale terminal.

(9) EVIDENCE APPENDIX

None

(10) RELATED PROCEEDINGS APPENDIX

None.